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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICANT : Eric Cohen-Solal et al.
SERIAL NO. : 09/703,419 EXAMINER : Kelly L. Jerabek
FILED : November 1, 2000 ART UNIT : 2612
FOR : METHOD AND APPARATUS FOR TRACKING AN OBJECT OF
INTEREST USING A CAMERA ASSOCIATED WITH A HAND-HELD
PROCESSING DEVICE



REPLY BRIEF TRANSMITTAL LETTER

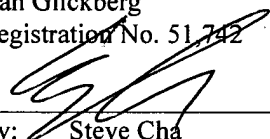
Mail Stop Appeal Brief-Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA. 22313-1450

Dear Sir:

Appellants respectfully submit three copies of a Reply Brief For Appellants that includes an Appendix with the pending claims. The Reply Brief is now due on Sunday, May 7, 2006.

Should the Examiner deem that there are any issues which may be best resolved by telephone communication, kindly telephone Applicants undersigned representative at the number listed below.

Respectfully submitted,
Yan Glickberg
Registration No. 51,742

By: 
Steve Cha
Attorney for Applicant
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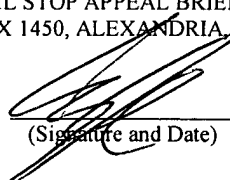
Date: May 8, 2006

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Steve Cha, Reg. No. 44,069
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(Signature and Date)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Before the Board of Patent Appeals and Interferences



the Application

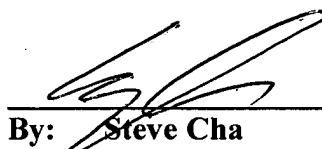
Inventor : Eric Cohen-Solal et al.
Application No. : 09/703,419
Filed : November 1, 2000
For : METHOD AND APPARATUS FOR TRACKING AN
OBJECT OF INTEREST USING A CAMERA
ASSOCIATED WITH A HAND-HELD PROCESSING
DEVICE

REPLY BRIEF

On Appeal from Group Art Unit 2612

Yan Glickberg
Registration No. 51,742

Date: May 8, 2006


By: Steve Cha
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Steve Cha, Reg. No. 44,069
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(Signature and Date)

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I. REAL PARTY IN INTEREST

Reference is made to the Appeal Brief and Examiner's Answer.

II. RELATED APPEALS AND INTERFERENCES

Reference is made to the Appeal Brief and Examiner's Answer.

III. STATUS OF CLAIMS

Reference is made to the Appeal Brief and Examiner's Answer.

IV. STATUS OF AMENDMENTS

Reference is made to the Appeal Brief and Examiner's Answer.

V. SUMMARY OF CLAIMED SUBJECT MATTER

Reference is made to the Appeal Brief and Examiner's Answer.

VI. GROUND FOR REJECTION TO BE REVIEWED ON APPEAL

Reference is made to the Appeal Brief and Examiner's Answer and repeated herein:

1. Claims 1, 4, 6, 10 and 12-15 stand rejected under 35 USC §103(a) as being unpatentable over the combination of Platte in view of Saburi; and
2. Claim 11 stands rejected under 35 USC §103(a) as being unpatentable over Platte in view of Saburi and further in view of Vincent.

VII. ARGUMENT

1. Claims 1, 4, 6, 10 and 12-15 stand rejected under 35 USC §103(a) as being unpatentable over the combination of Platte in view of Saburi.

In response to the arguments provided in the Examiner's Answer dated March 7 2006, Appellant respectfully submits that the Answer fails to show any motivation in the references that would lead one skilled in the art to combine the teachings of the references used to support the Examiner's reason for rejecting the claim.

The Examiner's Answer maintains the reason for the rejection of the above referred-to claims and states that with regard to the Platte reference "Platte discloses in figures 2 and 3 a video camera including an acceleration compensation apparatus. Platte mentions that portable cameras have a risk of capturing adversely affected images due to inadvertent acceleration (shake) of the camera housing. It can be seen in figure 1A that the camera produces a video signal of a target and the target is scanned in only a desired field. Therefore, the camera is provided with a wide field of view. ." (see Answer, page 4, lines 10-19,). The Answer, with regard to the Saburi reference states "Saburi discloses in figures 1-3 a portable videophone unit. The portable videophone unit body is provided with a camera for taking images. Captured images may then be transmitted to other devices. Therefore, it would have been obvious ... to integrate the camera including an acceleration compensation apparatus disclosed by Platte into [a] hand-held telephone as disclosed by Saburi." (see Answer, page 5, lines 7-14).

However, Appellant respectfully submits the Answer fails to show what would motivate one skilled in the art to combine the videophone of Saburi with the acceleration circuit of Platte. The law is clear that there must be some teaching in the references to support their use in the particular claimed combination. See Smithkline Diagnostics, Inc., v. Helena Labs Corp., 859 F.2d 878, 887, 8 USPQ 2d 1468, 1475 (Fed. Cir. (1988)). In order to establish a *prima facie* case of obviousness, three basic criteria must be met;

1. there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or combine the reference teachings;
2. there must be a reasonable expectation of success; and
3. the prior art reference must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must be found in the prior art, and not based on Appellant's disclosure. In re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

Saburi discloses a method operable in a portable videophone for an automatic response to an incoming call and two-way communication using at least images (see Abstract). "An object of the [Saburi device] is to provide a portable videophone unit which makes smooth two-way communication possible even with an opposite party who is not accustomed to the operation of portable videophone unit, which automatically responds to an incoming call from a particular calling party to permit two-way communications." (see col. 2, lines 1-7). Saburi discloses three modes of communication that include image only, voice only and VP comprising image and voice communication. Saburi teaches that in the VP mode voice and image data are provided to a multiplexer for transmission and the receiving unit separates the multiplexed signal into image data

and sound data. However, Saburi is silent with regard to providing any means to provide image compensation in either the sending or receiving unit.

Contrary to the statements made in the Answer, Saburi fails to provide any teaching or suggestion to include the acceleration circuits of Platte as is suggested in the Answer.

Appellant submits that with regard to obviousness the courts have found that “[t]he very ease with which the invention can be understood may prompt one to fall victim to the ... effect of a hindsight syndrome wherein that which only the invention taught is used against its teacher.” Iron Grip Barbell Company v. USA Sports, Inc., Docket no. 04-1149, Dec. 14, 2004, p. 4, (Fed.Cir. 2004), (quoting In re Kotzab, 217 F.3d 1365, 1369 (Fed. Cir. 2000). “Where an invention is contended to be obvious ... our cases require that there be a suggestion, motivation or teaching ... for such a combination.” *Id.* at 5 (quoting In re Fine, at 1074 (Fed. Cir. 1988). “This requirement prevents the use of ‘the inventor’s disclosure as a blueprint for piecing together the prior art to defeat patentability -- the essence of hindsight.’” *Id.* (quoting Ecolochem, Inc. v. So. Cal. Edison Co., 227 F.3d 1361, 1371-1372 (Fed. Cir. 2000), quoting In re Dembiczak, 175 F.3d 994, 999 (Fed. Cir.1999)).

Appellant believes that, in this case, the cited references have been impermissibly combined using the teachings of the instant application as a blueprint without any suggestion or reason for such combination from the references cited.

For at least the above reasons, Appellant respectfully submits that claim 1 is not rendered obvious over the combination of Platte and Saburi.

Reconsideration and withdrawal of this ground of rejection are respectfully requested.

With regard to independent claims 14 and 15, these claims were rejected for the same reason stated in rejected claim 1. Claims 14 and 15 include subject matter similar to that recited in claim 1. Hence, for the remarks made with regard to claim 1, which are repeated in overcoming the rejection of claims 14 and 15, Applicant respectfully submits that a *prima facie* case of obviousness has not been set forth.

Reconsideration and withdrawal of this ground of rejection are respectfully requested.

With regard to the dependent claims, these claims depend from the independent claims. Applicant respectfully submits that these claims are allowable at least for their dependence upon allowable base claims, without even contemplating the merits of the dependent claims, as it was held by *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) that if an independent claim is non-obvious under 35 U.S.C. §103(a), then any claim depending therefrom is non-obvious.

2. Claim 11 stands rejected under 35 USC §103(a) as being unpatentable over Platte in view of Saburi and further in view of Vincent

The rejection of claim 11 is in error because the combination of the references fails to show a limitation cited in independent claim 1 from which claim 11 depends.

Claim 11 depends from independent claim 1, which includes subject matter not disclosed by, and allowable over, the combination of Platte and Saburi. Applicant submits that claim 11 is allowable at least for its dependence upon an allowable base claim, without even contemplating the merits of the dependent claim for the reasons held

in *In re Fine*, 837 F.2d 1071, 5 USPQ 2d 1596 (Fed. Cir. 1988) (if an independent claim is non-obvious under 35 U.S.C. §103(a), then any claim depending therefrom is non-obvious).

In addition, claim 11 depends from claim 1, which has been shown to include subject matter not disclosed by the combination of Platte and Saburi and the Vincent reference fails to disclose the subject matter lacking in the combination of Platte and Saburi.


In view of the above, applicant submits that the above referred-to claims are patentable over the teachings of the cited references.

VIII. CONCLUSION

In view of the above analysis, it is respectfully submitted that the referenced teachings, whether taken individually or in combination, fails render obvious the subject matter of any of the present claims. Therefore, reversal of all outstanding grounds of rejection is respectfully solicited.

Respectfully submitted,
Yan Glickberg
Registration No. 51,742

Date: May 8, 2006

By: 
Steve Cha
Attorney for Applicant
Registration No. 44,069

IX. CLAIMS APPENDIX

Reference is made to the Appeal Brief and Examiner's Answer.

X. EVIDENCE APPENDIX

Reference is made to the Appeal Brief and Examiner's Answer.

XI. RELATED PROCEEDING APPENDIX

Reference is made to the Appeal Brief and Examiner's Answer.